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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91173189
Party	Defendant Igor Lognikov
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial No. 78/612,360 TEMPLATEMONSTER

MONSTERCOMMERCE, LLC

Opposer,

v

Opposition No. 91173189

IGOR LOGNIKOV

Applicant.

_____ /

**APPLICANT’S OPPOSITION TO OPPOSER’S MOTION TO STRIKE APPLICANT’S
AFFIRMATIVE DEFENSES IN ITS ANSWER TO THE SECOND AMENDED NOTICE
OF OPPOSITION**

COMES NOW, the Applicant, IGOR LOGNIKOV (“Applicant”), by and through his undersigned counsel, who respectfully opposes Opposer’s, MONSTERCOMMERCE, LLC (“Opposer”), motion to strike the timely pleaded affirmative defenses contained in his answer to the second amended notice of opposition. Opposer’s motion is yet still another attempt to protract the application process of Applicant’s TEMPLATEMONSTER mark, as evidenced by Opposer’s request to suspend proceedings, again, until the Board issues a ruling. (Motion, p. 12). No suspension is warranted as Affirmative Defenses 1, 2, 4 and 5 supporting dismissal of this proceeding are backed by established case law due to Opposer’s failure to plead with “absolute honesty.” Furthermore, Affirmative Defense 3 amplifies the denial of fraud alleged and is permissible under the applicable rules of practice. Thus, in law and fact, the motion should be denied, as moot, and the opposition dismissed.

ARGUMENT

The Board's Omnibus order of February 13, 2008 ("Order"), permitted Opposer to amend for a second time its notice of opposition, with limitations. (Order, p. 6). Applicant was required to answer the pleading which he did timely. At that time, he further pleaded certain affirmative defenses. The affirmative defenses rest on the legal precedent that dismissal of the opposition is warranted where the Opposer has not come before the Board with "absolute honesty."

An opposition proceeding is one based in equity.

[T]he opposer, to establish [its] right to protection, must come into court with clean hands. In other words, one seeking to prevent the registration of a trade-mark must be **guiltless of any false representations, either in the mark relied upon as a basis for opposition**, or in the advertising of goods on which the mark is used, and, **if it appears that absolute honesty in either of these particulars is lacking, the opposition should be dismissed.**

Federal Products Co. v. Lewis, 23 F.2d 759, 760 (C.A.D.C. 1927)(Emphasis Added); *T. Charles, Inc. v. Inecto, Inc.*, 48 U.S.P.Q. 428 (Com'r of Pats. 1941). Opposer, in its pleading, has not been "guiltless of any false representations."

A close reading of the second amended opposition establishes that Opposer alleges ownership of U.S. Reg. No. 2,947,268 for MONSTERCOMMERCE. (¶2). However, nowhere in the pleading does opposer allege any likelihood of confusion between that mark and the Applicant's TEMPLATEMONSTER mark. Rather, the pleading relies on Opposer's claim to a "family" of "Monster" marks, (¶4), and it is the family of Monster marks where Opposer alleges that confusion lies. (¶11).

Despite Opposer's claim to ownership of the family of Monster marks, Applicant defends the proceeding by establishing that Opposer is not the owner of all those marks, and this is

where Opposer is guilty of false representations to the Board. Applicant shows, in Affirmative Defense 5, that Opposer does not own in the United States the alleged family mark MONSTERLOCAL (U.S. Serial No. 76/658,138), and does not own the alleged family mark MONSTERMARKETPLACE, U.S. Reg. No. 3,361,201. These two “family” marks are owned in this country by Opposer’s parent Network Solutions, Inc. (“NS”).

The Board, in its Order, discussed the parent-subsidary relationship between NS and Opposer, and specifically addressed Applicant’s contention that NS, in foreign litigation, claimed that it owned all of the “Monster” family of marks.¹ (Order, pp. 8-9). However, the Board narrowly construed NS’s claim of ownership to a claim of foreign ownership only, *id*, though Applicant informed the Board that NS also claimed domestic United States ownership of these marks. (Applicant Reply to Opposer Opposition to Renewed Motion to Dismiss, p.3-4, and n.5). The Board never considered Opposer’s false claims of ownership of these marks in the U.S., when NS was at all times their owner in this country.

Now, to allay any confusion over the subject, Opposer concedes that NS, and not it, owns MONSTERLOCAL and MONSTERMARKETPLACE here in the United States. (Motion, p.9). This is contrary to the continued assertions of Opposer as alleged in Paragraph 4 of the second amended notice of opposition, and proves, beyond doubt, that the allegation is false. Opposer’s argument that it can own some of the family of marks and that NS can own others of the same family is of no moment, and misses the decision of *Federal Products, supra*. The point is that because

¹That litigation, in which NS opposed the registration of Applicant’s sister Community Trademark application for TEMPLATEMONSTER, CTM App. No. 005074761, filed before the Harmonization in the Internal Market, recently terminated in favor of Applicant. As part of the termination, NS was ordered to pay Applicant his costs of the proceeding. NS is now overdue in its obligation to satisfy the costs award to Applicant.

Opposer falsely alleged ownership of marks upon which it relies to oppose TEMPLATEMONSTER, it has therefore not come before the Board with “absolute honesty.”

This is not a case where Opposer thought that it owned the marks, and was wrong. The Opposer’s motion makes very clear that it has always known that NS is the owner in the United States of MONSTERLOCAL and MONSTERMARKETPLACE. Thus, Opposer falsely, and fraudulently, misrepresented itself as the owner of at least two of the family of marks in contravention to the absolute honesty requirement commanded by *Federal Products*. As a result, *Federal Products* dictates that the case be dismissed because Opposer is not entitled to the equitable relief that it seeks.

Because the Board never addressed in its Order these facts and *Federal Products*, the affirmative defenses are well grounded in fact and law. And, it is upon these facts and law that the affirmative defenses that support dismissal are indeed proper, including Affirmative Defenses 1, 2², 4, and 5. Further, Affirmative Defense 3 amplifies Applicant’s denial of the allegation of fraud contained in the operative notice, and is “permitted by the Board because [it] serve[s] to give the plaintiff fuller notice of the position which the defendant plans to take in defense of its right to registration.” TBMP §311.02(d).

CONCLUSION

Applicant respectfully submits that the motion should be denied, as moot, with the proceeding dismissed under the authority of *Federal Products, supra*. In the alternative, there should

²Moreover, Affirmative Defense 2 is supported by the Order, n.3, which authorizes the defense of equitable estoppel so long as the Applicant alleges, which he does, specific inaction by Opposer upon which Applicant relies that Opposer would not assert any alleged claim against the TEMPLATEMONSTER mark.

be no suspension of the nearly two year old proceeding, and Opposer should submit expeditiously whatever proof it has in support of its claim of a likelihood of confusion between TEMPLATEMONSTER and the alleged “family of Monster marks.”

Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing has been served by United States Postal Service first class regular mail, and addressed to counsel for the Opposer:

Brian J. Winterfeldt
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this 22nd day of April, 2008.

s/Richard S. Ross, Esq.
Richard S. Ross, Esq.